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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,063	11/17/2006	Hartmut Karl Sauer	1204.1128101	5913
28075 7590 09/26/2008 CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				
EXAMINER				
HARMON, CHRISTOPHER R				
ART UNIT		PAPER NUMBER		
3721				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/591,063

**Applicant(s)**

SAUER ET AL.

**Examiner**

Christopher R. Harmon

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims 17-23 drawn to an invention nonelected without traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Double Patenting***

2. Claim 14 objected to under 37 CFR 1.75 as being a substantial duplicate of claim 25. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 10-12, 15-16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartels (US 5,927,047).

Bartels discloses a banding system comprising machine frame; band feed mechanism 1 for feeding paper web 7; means for forming a loop of band material around the products inserted into the loop comprising movable guide 14 and

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transporting means 11; cutting means 2; vacuum means (see column 4, lines 23+); transporting rolls/belt rollers (see column 4, lines 27+) driven synchronously with belts/rings 11 by tensioning/pressure means; see figure 4. The guide of the loop forming means 14 is movable with respect to the frame and the band feeding mechanism. Discharging unit 6 comprises multiple pushers; see figures 5-6.

Bartels does not directly disclose a welding system but rather provide for a gluing system, however welding systems are commonly used in the art, as admitted. It would have been obvious to one of ordinary skill in the art to substitute a welding system for the gluing system in the invention to Bartels for joining the band ends together. The common knowledge modification in the above paragraph is taken to be admitted prior art because applicant failed to traverse the examiner's previous assertion of Official Notice.

Regarding claim 3, arcuate guide of forming means 14 operates in a pivoting manner(see column 4, 20+), however at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a sliding rail means on the frame because Applicant has not disclosed that the sliding rail means provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a pivotal mounting because both are reciprocable mechanisms that would accomplish a graduating movement.

Regarding claim 4, Bartels does not disclose the manner of actuating forming means 14, however pistons are well known in the art for actuating translation of mechanical parts, as admitted. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a piston for actuating the movement of forming means 14 in the invention to Bartels. The common knowledge modification in the above paragraph is taken to be admitted prior art because applicant failed to traverse the examiner's previous assertion of Official Notice.

Regarding claim 6, Bartels does not directly disclose the composition of belts/rings 11, however note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It would have been obvious to one of ordinary skill in the art at the time of the invention to include rubber for the composition of belts/rings of Bartels in order to provide friction.

Regarding claim 24, note that it would have been obvious to one of ordinary skill in the art to place a plurality of banding machines of Bartels adjacent one another since it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Also, duplication of the essential working parts of a device involves only routine skill in the art and that "section 103 cannot easily be satisfied by inventions that rearrange old elements in new combinations with each element performing the same function it performed in the prior art, even though the new combination produces

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a more striking result than the old ones. *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 452-453 (1976). Unless the combination is "synergistic, that is, 'result[ing] in an effect greater than the sum of the several effects taken separately,'" it cannot be patented. *Id.*, citing Anderson's -- *Black Rock v. Pavement Co.*, 396 U.S. 57, 61, 163 USPQ 673, 674-675 (1969)." *St. Regis Paper Company v. Bemis Company, Inc.*, 193 USPQ 8 (1977).

Regarding claims 11-12, arcuate guide forming means 14 is an inverted U with a channel. Main vacuum pump is connected to suction box 10 which provides negative pressure in and around the belt/rings 11; as noted supra.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartels (US 5,927,047) in view of Langemaat (US 6,604,345).

The channel of the forming means 14 is not coupled to an auxiliary vacuum pump nor is connected with a corresponding open extremity of the first channel portion. However Langemaat recognizes a similar system requiring multiple channels for a belt conveyor system for providing suction on the band of a banding operation and the need for adequate pressure around the loop; see column 1, lines 44+. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an auxiliary vacuum pump in the invention to Bartels for supplying pressure around the banding loop (in second channel) for additional help in positioning the band about the product.

6. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartels (US 5,927,047) in view of Dekker (US 5,755,084).

Bartels does not directly disclose a pressure means as a pressure stamp, however Dekker provides for a cutting/welding/pressure stamp 15 displaceable with respect to means for forming a loop for putting pressure on the band and the products banded therein; see figures 3-4. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the pressure stamp of Dekker in the invention to Bartels for insuring the completion of the banding operation and avoiding residual glue.

***Allowable Subject Matter***

7. Claim 25 is allowed.

***Response to Arguments***

8. Applicant's arguments filed 7/18/08 have been fully considered but they are not persuasive. Bartels discloses the claimed components of the banding system capable of performing the banding operation. While features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed.Cir. 1990). While the preamble of the claim states a banding system for "piled products, such as securities", etc., no limitation precludes a roll of shingled piled products to be banded. Furthermore note that the preamble of a claim is not treated as a claim limitation.

The movable means for forming a loop has lug 16 which is in a contacting position (ie. through the product 9, figure 6) with the feeding mechanism comprised of belts 11 forming feeder belt 17 during in the operating position and open position (figure 4-5) as it pivots on shaft 15; see figure 6. Note that the function of banding the products is performed by moving the loop forming means between open and operating positions. Indirect contact of the separate means guide the products into a banded unit.

Furthermore note that the pivoting operation of arm 14 of the loop forming means if fully capable of being pivoted into contact with the belt 17, note that lug portion 16 has independent pivotal capability (ie. mounted by singular shaft/point; see figure 4) and a non uniform shape. While Bartels does not directly disclose the operational position of lug 16 (freely rotating on shaft or fixed) one of ordinary skill in the art would easily recognize that in an operational position in order to contact the product upon the feeding means 17 a freely rotating/pivoting member 16 on shaft as shown in figure 4 may provide a guiding member with a trailing end (downstream end of product transport) contacting the belt 17 to insure proper alignment of the products between the two. Note the trailing end of lug 16 contacting the belt (due to the its shape) would insure contact with products thereupon without setting a specific height and provide for entry of the products below. Further note the position of the shaft 15 in relation to the positions of lug 16 in figures 5 and 6.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher R Harmon/  
Primary Examiner, Art Unit 3721